

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellants : Stefano FACCIN et al.
Application No. : 09/758,267
Confirmation No. : 4056
Filing Date : January 12, 2001
Art Unit : 2616
Examiner : Ian N. Moore
Title : COMMON CHARGING IDENTIFIER FOR
COMMUNICATION NETWORKS
Docket No. : NOKIA.30US

March 6, 2008

RESPONSE TO OFFICE COMMUNICATION RE: APPEAL

Sir:

Appellants hereby respond to the Office Communication Re: Appeal dated on or about February 6, 2008 and request reconsideration thereof for at least the following alternative reasons. The Communication is signed by SPE Doris To and is apparently initialed (unintelligible) as well. It states that the appeal in this application "will be dismissed unless corrective action is taken" and also fills in a check box stating that the appeal "is DISMISSED". The grounds for dismissal appear to be that the claimed invention recited under Summary of Claimed Subject Matter "is not mapped to the independent claims on appeal, which shall refer to the specification by page and line number, and to the drawings, if any be reference numbers." Appellants respectfully decline to "correct" their Appeal Brief.

First, the Communication asserts that "the claimed invention . . . is not mapped to the independent claims on appeal..." It is not clear from this assertion exactly what is regarded as the defect in the Appeal Brief. Furthermore, the term "mapped" is not defined in the Rules governing the Appeal Brief (37 CFR 41.37 et seq.), the publication of the Rules at 69 Fed. Reg. 49960 (August 12, 2004), or in Chapter 12 of the Manual of Patent Examining Procedure (MPEP). The assertion is also grammatically unclear and confusing. The claims state the subject matter which the appellants regard as their invention (see 35 USC 112) so it is nonsensical and circular to assert that the claimed invention must be mapped to the independent claims on appeal.

Secondly, it is respectfully submitted that the Appeal Brief fully complies with 37 CFR 41.37(c)(1)(v). The Summary of Claimed Subject Matter in the Appeal Brief summarizes the independent claims being appealed and includes various references to the specification by page and line number, and to figures of the drawings. This is sufficient to comply with the Rule. The Rule does not refer to, mention, or require mapping of the claims to the specification. The Communication appears to attempt to impose requirement on the Appeal Brief beyond that stated in, or required by, 37 CFR 41.37(c)(v). Neither the publication of the Rule at 69 Fed. Reg. 49960 (August 12, 2004), nor Chapter 12 of the Manual of Patent Examining Procedure (MPEP), indicates that the rule requires mapping.

Assuming thirdly, merely for the sake of argument, that the Rule explicitly stated that the appeal could be dismissed unless the Appeal Brief included "mapping" of the independent claims, appellants respectfully submit that such Rule would be improper and without statutory authority. The claims have not been rejected under 35 USC 112, first or second paragraph. If it is believed that the brief fails to show that the final rejection should be reversed on the merits, then the Examiner is free to assert as much in the Examiner's Answer and the Board can decide as much in their opinion. Appellants have a right of appeal to the Board of Patent Appeals and Interferences pursuant to 35 USC 192. The Rule and Notification improperly attempt to control the substantive content of appellant's brief under threat of depriving appellants of their statutory right to appeal.

Finally, despite MPEP 1203.05, appellants respectfully submit that the Examiner (or SPE Doris To) does not have the authority to require such a correction of the appeal brief as is apparently being demanded or to dismiss the appeal in this application. Although 35 USC 7(c) did permit a primary examiner to be temporarily designated as a member of the Board, that statute was

deleted in 1999. In any event, appellant respectfully submits that it is a fundamental violation of due process for any Examiner or other official in the technology Center, to claim authority to dismiss the appeal based on the substantive content of appellant's brief.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert M. Bauer", written over a horizontal line.

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March 6, 2008

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